

P19203.A09

REMARKS

Upon entry of the present Reply, Applicant will have amended claims 1, 27, 34, 36 and 39 and respectfully requests reconsideration and withdrawal of the outstanding rejection set forth in the above-mentioned Official Action.

Initially, Applicant wishes to note that contrary to the Examiner's indication, claims 1 and 27-40 are pending, since claims 2-26 have been canceled.

Applicant notes the Examiner's approval and acceptance of the drawing correction filed on March 26, 2003. Together with the present Reply, Applicant is submitting a formal drawing incorporating the changes approved by the Examiner.

Applicant further notes with appreciation the Examiner's acceptance of the proposed specification corrections filed on March 26, 2003.

Initially, Applicant wishes to address the finality of the above-noted Official Action. In particular, Applicant respectfully submits that the outstanding Official Action has been improperly (i.e. prematurely) made final. As noted in the Response filed on March 26, 2003 at page 18, claim 1 has been amended by incorporating therein the features of claims 2, 3 and 4. Accordingly, the features of claim 1 as amended in the Response of March 26, 2003 were substantially before the Examiner for consideration. Of course, in amending the claims, the language thereof was clarified and the idiom improved so as to be in accord with U.S. practice. Accordingly, the citation of new references cannot have been necessitated by

P19203.A09

Applicant's amendment but in fact were necessitated by the shortcomings of the outstanding rejection. Accordingly, because at least claim 1 was amended to contain features from previously pending and considered claims, it is respectfully submitted that the finality of the present action is inappropriate. Accordingly, reconsideration and withdrawal of the finality of the outstanding rejection is respectfully requested, in due course.

In the outstanding Official Action, the Examiner rejected claims 1 and 27-40 (all the claims pending the present application) under 35 U.S.C. § 103 as unpatentable over TOYODA et al. (U.S. Patent No. 5,812,278) in view of IDEHARA (U.S. Patent No. 6,438,605) and further in view of REED et al. (U.S. Patent No. 6,061,739).

In setting forth the rejection, the Examiner asserted that TOYODA et al. teaches an image transmitting apparatus and a memory that stores a table including a fixed address of the image receiving apparatus as well as a processor configured to obtain the current IP address of the image receiving apparatus by use of the fixed address stored in the memory. Applicant respectfully submits that the Examiner is incorrect.

TOYODA et al. has no need to obtain a current IP address of the image receiving apparatus since TOYODA et al. does not deal with a receiving apparatus that does not have a fixed address. Thus, the need for the memory which stores a correspondence between current IP addresses and fixed addresses is not present in TOYODA et al.

P19203.A09

In addition, each of Applicant's claims recite that image data is transmitted to an image receiving apparatus to which "a changeable IP address is assigned by an external apparatus". It is respectfully submitted that TOYODA et al. does not relate to a device and does not disclose a device to which a changeable IP address is assigned by an external apparatus. TOYODA et al. relates to an Internet facsimile device which is capable of communicating with a receiving apparatus which has an unchangeable address. Therefore, TOYODA et al. is unrelated to the problem to which the present invention is directed and is unrelated to the problem which the present invention solves.

In addition, TOYODA et al. has numerous other deficiencies and short comings with respect to the recitations of the claims in the present application. In particular, the Examiner asserts that column 11, lines 29-30 relate to a processor which obtains the current IP address of the image receiving apparatus by the use of the fixed address stored in the memory. Applicant respectfully traverses and submits that the noted portion of TOYODA et al. relates to transmission and reception of mail data, while adding particular paper size and image resolution information to the mail data transmitted, and judging whether the particular paper size and image resolution are treatable in the facsimile type electronic mail apparatus of the receiving side. This has nothing to do with obtaining the current IP address of the image receiving apparatus by use of the fixed address stored in the memory.

P19203.A09

Moreover, the Examiner's reliance on column 10, lines 64-65 is also inappropriate. In particular, that portion of TOYODA et al. merely relates to the ordinary ROM and RAM that is used in the image transmitting apparatus. This portion of TOYODA et al. does not disclose a table that stores a fixed address of the image receiving apparatus, as recited in Applicant's claim.

Moreover, column 1, lines 45-46 of TOYODA et al. cited by the Examiner do not disclose a memory that stores the fixed address in association with a destination mail address. Rather, this portion of TOYODA et al. discloses that a read only memory stores a program and a random access memory stores data used in the program.

Finally, column 7, lines 39-42 of TOYODA et al. merely disclose that the transmitter's electronic mail address, the identification information and the receiving electronic mail address are stored in the storing means in correspondence with each other. However, this portion of the disclosure of TOYODA et al. does not imply in any manner the provision of a searcher that searches for a fixed address corresponding to the destination mail address input by the inputter wherein the processor obtains the IP address of the image receiving apparatus by use of the fixed address searched by the searcher, as those terms are each defined in Applicant's claims. Accordingly, TOYODA et al. clearly contains numerous additional deficiencies in addition to those admitted by the Examiner.

P19203.A09

The Examiner admits (in the rejection) that TOYODA et al. does not teach direct and indirect transmission of an image. However, the Examiner relies on IDEHARA for this feature. In this regard, Applicant notes that IDEHARA discloses a system wherein the user selects the route and the associated communication function from a displayed list and communication proceeds along the route and function selected by the user. On the contrary and according to the teachings of the present invention, it is not necessary for the user to select a transmission route. In this regard, the Examiner's attention is respectfully directed to, e.g., column 10, lines 21-27 of IDEHARA as well as the features recited in claim 1 thereof.

In direct contrast and according to the features of the present invention, the transmitter directly transmits the image data to the image receiving apparatus by use of the IP address if an IP address is obtained by the processor or indirectly transmits the image data to the image receiving apparatus via a mail server when the IP address is not obtained by the processor. It is respectfully submitted that IDEHARA does not disclose at least the above-noted feature of the present invention.

The Examiner further admits that even TOYODA et al. modified in view of IDEHARA does not teach a changeable IP address. The Examiner relies upon REED et al. for changeable IP addresses. However, Applicant does not claim the concept of a changeable IP address per se. Rather, Applicant claims the combination of features recited in Applicant's

P19203.A09

claims which include, inter alia, a memory that stores a table including a fixed address of the image receiving apparatus, a processor configured to obtain the current IP address of the image receiving apparatus by use of the fixed address stored in memory, a transmitter that directly transmits image data to the image receiving apparatus by use of the IP address wherein the memory stores the fixed address in association with a destination mail address. Further, Applicant's invention is directed to transmitting image data to an image receiving apparatus to which a changeable IP address is assigned by an external apparatus. Moreover, the present invention relates to an inputter that inputs the destination mail address, a searcher that searches the fixed address corresponding to the destination mail address input by the inputter wherein the processor obtains the IP address of the image receiving apparatus by the use of the fixed address searched by the searcher. Finally, according to the features of the present invention, the transmitter, in the first mode, directly transmits image data to the image receiving apparatus by use of the IP address and in the second mode indirectly transmits the image data to the image receiving apparatus via a mail server.

The operation of the transmitter in accordance with the first and second modes is in response to whether the IP address is obtained or is not obtained by the processor. It is respectfully submitted that with regard to the changeable IP address as recited in Applicant's claims, REED et al. contains no significant teachings. Applicant again notes that he is not claiming the concept of changeable IP addresses that are assigned by an external apparatus

P19203.A09

per se. Rather, Applicant is claiming the combination of features recited in each of his independent claims.

Moreover, Applicant submits that the Examiner has set forth no reason to modify the teachings of TOYODA et al. in view of the teachings of each of the secondary references cited by the Examiner. In this regard, there is no need whatsoever for direct and indirect transmission modes in TOYODA et al. because TOYODA et al. merely relates to an Internet facsimile apparatus, which utilizes an e-mail server and is not particularly concerned with facsimile transmission as an alternative thereto. While the Examiner asserts a motivation, it is not seen how this motivation flows from the prior art but rather represents speculation on the part of the Examiner.

Similarly with respect to the modification of TOYODA et al. and IDEHARA in view of REED et al., it is respectfully submitted that the motivation set forth by the Examiner is not based on the prior art of record. Further, it is submitted to be somewhat ironic that the Examiner relies upon REED et al. to modify TOYODA et al. and IDEHARA by use of a motivation that invokes automatic assigning of an IP address, since IDEHARA explicitly teaches non-automatic routing. Thus, it is respectfully submitted that the Examiner's combination is unmotivated by the prior art and is thus improper and inappropriate for this additional reason.

P19203.A09

By the present Reply, Applicant has amended the claims to more clearly define the features of the present invention. In particular, the fixed address has been further defined as a MAC address. In addition, the operation of the device according to the first or second modes has been more directly related to the results of the function of the processor. It is respectfully submitted that in view of the fact that the finality of the outstanding Official Action is improper, these changes are appropriate for entry. Moreover, it is noted that these changes even more clearly provide basis for the patentability of the claims in the present application as these features are not disclosed in the claimed combination by any of the references, even if combined as proposed by the Examiner.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections, entry of the present amendment and an indication of the allowability of all the claims pending herein, in due course.

Applicant notes that contact was made with Examiner Baugh on September 3, 2003 in an effort to set-up an interview for discussing the propriety of the finality and the merits of the rejection in the present application. However, since the case was not available to the Examiner, such interview was not conducted. It is Applicant's intent to conduct such an interview shortly after filing of the present Reply and Applicant requests the Examiner's forbearance in acting on the present Reply prior to such an interview being conducted.

P19203.A09

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has pointed out the impropriety (i.e., prematurity) of the finality of the outstanding Official Action in the present application. Applicant has further amended the claims to even more clearly define the novel features thereof.

Applicant has discussed in detail each of the references cited by the Examiner and has pointed out the shortcomings thereof with respect to the claims in the present application, both individually as well as in combination. Additionally, Applicant has pointed out the shortcomings in the motivation for the proposed combination set forth by the Examiner.

Accordingly, Applicant has provided a clear evidentiary basis supporting entry of the present amendment as well as the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

P19203.A09

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Kiyoshi TOYODA


Bruce H. Bernstein
Reg. No. 29,027

10-29-03

September 4, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

RECEIVED
CENTRAL FAX CENTER

OCT 29 2003

OFFICIAL

OCT. 29. 2003 12:51PM

GREENBLUM&BERNSTEIN

Applicant: Toshi TOYODA

Confirmation No. 5789

Attorney Docket No. P18**

Title: A SYSTEM AND METHOD FOR TRANSMITTING AND RECEIVING

FOR IMAGE

Responsive to Official Communication dated: June 4, 2003
REPLACEMENT SHEET

NO. 6317 P. 22

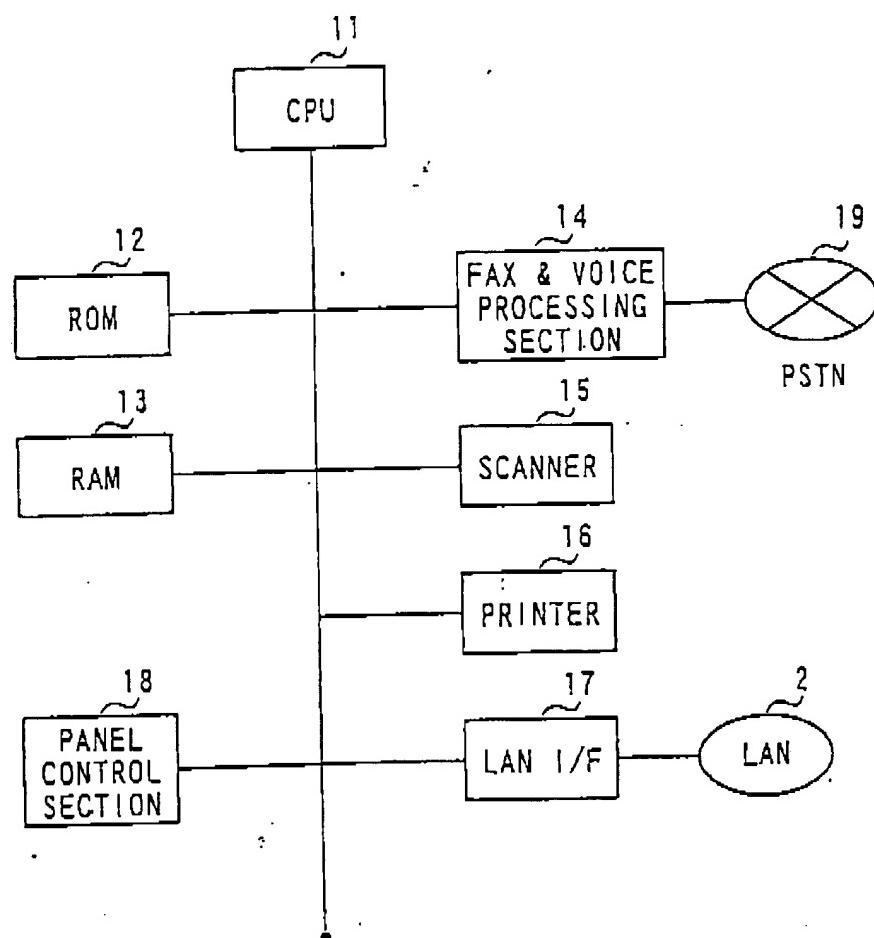


FIG. 2